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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,072	08/15/2001	Robert G. Burke	T8466357US	8932
26912	7590	05/05/2004	EXAMINER	
GOWLING LAFLEUR HENDERSON LLP COMMERCE COURT WEST, SUITE 4900 TORONTO, ON M5L 1J3 CANADA			ARNOLD III, TROY G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,072

Applicant(s)

BURKE ET AL.

Examiner

Troy Arnold

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7/4-5, 8, 9, 10/2-5, 11-15, 17-22 and 16/2-5 is/are rejected.
- 7) ☒ Claim(s) 6, 7/6, 10/6 and 16/6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 21 is objected to because of the following informalities: it is labeled as "currently amended" but no amendments are made in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 14 and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the last line of claim 10, Applicant claims the catalyst apex as being "1% to 5% of the length of the foot." The foot has no antecedent basis, as no foot is distinctly claimed in claim 2 or 10. Therefore this measurement claim becomes indefinite. Claims 20 and 22 claim a radial geometry region. Is this the radial geometry region (11) shown in Fig 5 or Fig 7? Only the one shown in Fig 5 aligns with the long axis center of rotation of a wearer's foot.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellis, III, US Patent No. 5,317,819, hereinafter "Ellis." Regarding claim 2, Ellis teaches an article of footwear comprising an upper as claimed, a midsole/outsole 28 as claimed, where the midsole 28 has a heel region and a convex curvature to the outer face in the heel region. See Fig 15 for example. Also regarding claim 2, see Figs 15, 18b, 20d, and 22 b of Ellis. It appears that in at least one of the embodiments taught by Ellis has the transverse radius of curvature coincident and alignable as claimed. Regarding claim 3, see Fig 20e. Once again, it appears that in at least one of the embodiments taught by Ellis has the longitudinal radius of curvature coincident as claimed. See also Daswick who teaches a midsole heel structure with convex (compound) curvature.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 7/4, 7/5, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Skaja. Ellis teaches all the limitations of claim 4 except the region of enhanced flexibility, as claimed. Skaja teaches a region of enhanced flexibility demarcated by grooves 12. It would have been obvious in view of Skaja to one

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of ordinary skill in the art at the time the invention was made to incorporate the flex region of Skaja into the invention of Ellis for the purpose of making the metatarsal region more flexible and comfortable for walking. Regarding claim 5, see item 12 of Skaja.

Claims 10/2 and 10/3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Burke et al. Regarding the height limitation, Burke specifies between 5.28% and 7.6% of the length of the foot. It clearly would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the height of the apex of the catalyst of Burke, especially within 0.28%, to suit a particular foot shape or bone structure.

Claims 10/4, 10/5, 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Skaja, and further in view of Burke et al. Ellis as modified regarding claim 4 teaches all the limitations of claim 10 except the catalyst as claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the catalyst of Burke into the midsole of Ellis as noted in the paragraph above. Regarding claim 11, also see paragraph above. Regarding claims 12 and 14, see Fig 5 of Burke.

Claims 13, 15 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Skaja and Burke et al, and further in view of Marc and Weitsen. Ellis as modified by Skaja and Burke teaches all the limitations of claims 13 and 15 except the receptacle having sidewalls perpendicular to the outer face of the midsole. Both Weitsen and Marc teach receptacles for accommodating resilient

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members in midsoles, which have walls perpendicular to the outer face of the midsole. It would have been obvious in view of Marc and Weitsen to one of ordinary skill in the art at the time the invention was made to make the walls of the receptacle of Burke perpendicular to the outsole so as to better retain the resilient member. Ellis as modified regarding claim 15 teaches all the limitations of claim 18 except the heel region including a more compressible cushioning region. Marc teaches a more compressible heel cushion 20. It would have been obvious in view of Marc to one of ordinary skill in the art at the time the invention was made to incorporate a more compressible heel cushion into the invention of Ellis as modified for the purpose of reducing shock to the heel bone. Ellis teaches the limitations of claim 19 as above. Regarding claim 21, Ellis structure as modified will flatten to some degree when supporting the weight of a wearer. Regarding claim 22, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a cushioning region such as that taught by Marc 20 into the forefoot of the midsole structure of Ellis as modified, for the purpose of reducing shock in the forefoot area. Ellis' forefoot region will clearly flatten to some degree when supporting the weight of a wearer.

Claims 16/2 and 16/3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Marc. Ellis teaches all the limitations of claims 16/2-3 except the heel region including a more compressible cushioning region. Marc teaches a more compressible heel cushion 20. It would have been obvious in view of Marc to one of ordinary skill in the art at the time the invention was made to incorporate a more

compressible heel cushion into the invention of Ellis for the purpose of reducing shock to the heel bone.

Claims 16/4 and 16/5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Skaja and further in view of Marc, for the same reason noted in the paragraph above.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Skaja and Burke et al, and further in view of Marc, as above.

Allowable Subject Matter

Claims 6, 7/6, 10/6 and 16/6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 10 February 2004 have been fully considered but they are not persuasive. Regarding the amendments to claims 20 and 22, Ellis teaches a radial geometry region alignable with the longitudinal axis of a wearer's foot, as claimed. Regarding the remarks beginning at the middle of page 9 through the top of page 10, Applicant does not claim a "constant radius to be developed about the axis of rotation of the calcaneus" or a "uniform radius" – Applicant is reading limitations into the claims. Furthermore, Applicants disclosure of two radial geometry regions, along different axes (shown in Fig 5 versus Fig 7 make it unclear exactly what the (unloaded)

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shape of the bottom of the heel portion of the Applicant's article looks like. Claims 1-3 were previously rejected with the Ellis reference, now claims 2 and 3 are. Regarding the arguments at the bottom of page 10, it is submitted that Ellis as modified by Skaja teaches all the distinct structural limitations claimed in the claims, as noted above. Furthermore, the exact positioning of a region of enhanced flexibility is clearly well within the capability of one of ordinary skill in the art. Additionally, it is noted that the Applicant is reading limitations into the claims. For example, regarding the region of enhanced flexibility, there is nothing in the claims concerning "the nature of the(ir) curvature" of the flex lines, as argued at the bottom of page 10 and top of 11. The footwear arts are very old. The Applicant's claims are relatively broad. Regarding the comments in the middle of page 11, claim 10 is made indefinite as noted above because Applicant sizes the apex based on a non-existent and indefinite standard, a wearer's foot. A foot is not, and cannot be claimed. Regarding the comments at the top of page 12, the Marc reference US Patent No. 5,068,983 was inadvertently left off the Notice of References cited. A new Notice is submitted which includes it. Applicant states that claims 20-22 have been deleted, at the end of the second paragraph of page 12. This appears to be incorrect. Regarding the third paragraph on page 12, the Examiner would simply reply that a broadly-claimed collection of well known features, each old in their art and doing what they are well known to do, does not necessarily confer patentability.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Arnold whose telephone number is 703-305-0621. The examiner can normally be reached on Tuesday-Thursday, 9:30-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Troy Arnold
Examiner
Art Unit 3728

TGA
4/20/04



Mickey Yu
Supervisory Patent Examiner
Group 3700